



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No. 12

LEE R. OSMAN
HOLLAND & HART
P.O. BOX 8749
555 17TH STREET, SUITE 3200
DENVER, CO 80201

COPY MAILED

AUG 28 2003

OFFICE OF PETITIONS

In re Application of	:
John A. Doherty, et al.	: DECISION DISMISSING PETITION
Application No. 09/862,652	: UNDER 37 CFR 1.137(b)
Filed: May 21, 2001	:
Attorney Docket No. 5437.05	:

This is a decision on the petition, filed July 29, 2003, which is being treated as a petition under 37 CFR 1.137(b) to revive the instant nonprovisional application for failure to timely notify the U.S. Patent and Trademark Office (USPTO) of the filing of an application in a foreign country, or under a multinational treaty that requires publication of applications eighteen months after filing. See 37 CFR 1.137(f).

There is no indication that the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. However, in accordance with 37 CFR 1.34(a), the signature of Gregory P. Durbin appearing on the petition shall constitute a representation to the United States Patent and Trademark Office that he is authorized to represent the particular party in whose behalf he acts. However, if Mr. Durbin desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted. A courtesy copy of this decision is being mailed to petitioner. Nevertheless, all future correspondence regarding this application file will be directed solely to the address of record until otherwise instructed.

The petition is **dismissed** as inappropriate for the reasons stated below.

The record discloses that, on May 21, 2001, the date of filing of the instant application, a Request and Certification under 35 U.S.C. § 122(b)(2)(B)(i) was filed certifying that "the invention

disclosed in the attached **application has not and will not** be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication at eighteen months after filing."

Petitioner now requests under 35 U.S.C. § 122(b)(2)(B)(ii) that the Request and Certification Under 35 U.S.C. § 122(b)(2)(B)(i) be rescinded and the application be revived because this application became abandoned for failure to notify the USPTO within 45 days of the filing of a corresponding international or foreign application. In this regard, petitioner explains that while an international or foreign application corresponding to the instant application was filed on November 18, 1997, the claims pending in the present application were subsequently filed in the corresponding foreign application on August 20, 2002. However, by petitioner's own admission, the "Canadian application has basically the same specification and drawings as the above-referenced patent application."

However, the instant nonprovisional application did not become abandoned as a result of the filing of a corresponding application filed in another country, or under a multilateral international agreement, **subsequent** to the filing of the present application. 35 U.S.C. § 122(b)(2)(B)(iii) states:

An applicant who has made a request under clause (i) but who **subsequently files, in a foreign country or under a multilateral international agreement** specified in clause (i), an application directed to the invention disclosed in the application filed in the Patent and Trademark Office, shall notify the Director of such filing not later than 45 days **after the date of the filing of such foreign or international application**. A failure of the applicant to provide such notice within the prescribed period shall result in the application being regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the notice was unintentional [emphasis supplied].

The facts of this case are that the subject application was filed on May 21, 2001, and the corresponding foreign application was filed on November 18, 1997. The statute does not provide for the

situation where a certification under 35 U.S.C. § 122(b)(2)(B)(i) was made, despite the fact that an application was previously filed in another country or under the multilateral international agreement. The provisions of 35 U.S.C. § 122(b)(2)(B)(iii) only provide for revival in the situation where a certification was made under 35 U.S.C. § 122(b)(2)(B)(i) at the time of filing the application and an application was subsequently filed in a foreign country without notifying the Office within 45 days of the filing thereof.

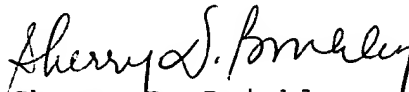
In view of the above and since this application did not become abandoned pursuant to the provisions of 35 U.S.C. § 122(b)(2)(B)(iii), a petition to revive under the provisions of 37 CFR 1.137(b) is inappropriate and, therefore, must be dismissed. While immaterial to the question, petitioner's comments about the presence or absence of claims in the Canadian application are noted. It is pointed out that the statute, 35 U.S.C. § 122(b)(2)(B)(iii) only speaks to the filing of "a[n foreign or multilateral international] application directed to the invention disclosed in the application filed in the United States Patent and Trademark Office." The statute simply does not make the abandonment *vel non* of the United States application contingent on whether there were claims in the foreign or multilateral international application or not.

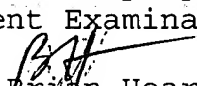
As requested, the Request and Certification Under 35 U.S.C. § 122(b)(2)(B)(i) has been rescinded. A Notice Regarding Rescission of Nonpublication Request indicating a projected publication date of November 27, 2003 accompanies this decision.

The rules and statutory provisions governing the operations of the USPTO require payment of a fee on filing each petition. See 35 U.S.C. § 41(c)(7). The fee is due independently of favorable or unfavorable treatment; rather, it is for consideration of the petition. Accordingly, the petition fee of \$650.00 will not be refunded.

This application is being forwarded to Technology Center AU 3752 for examination in due course.

Any inquiries concerning this decision may be directed to the undersigned at (703) 305-9220.


Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy


Conferee: Brian Hearn
Senior Petitions Examiner

ATTACHMENT: Notice Regarding Rescission of Nonpublication Request

cc: GREGORY P. DURBIN
DORSEY & WHITNEY LLP
REPUBLIC PLAZA BUILDING, SUITE 4700
370 SEVENTEENTH STREET
DENVER, CO 80202-5647